

U.S. Patent Application Serial No. **09/700,908**  
Amendment filed February 11, 2005  
Reply to OA dated September 14, 2004

**REMARKS**

Claims 1-12 and 14-25 are pending in this application. Claims 1-10 and 18-24 are withdrawn from consideration. No amendment is made in this Response.

**Claims 25, 11, 12 and 16 are rejected under 35 U.S.C. §102(b) as being anticipated by Nakagawa (JP 08-090688).** (Office action paragraph no. 6)

The rejection of claims 25, 11, 12 and 16 is respectfully traversed, and reconsideration of the rejection is requested.

The amendment to claim 25 made on June 29, 2004, and entered in the Request for Continued Examination dated July 28, 2004, added the recitation “wherein the outer reinforcing shell layer is formed by injection molding at an injection pressure of 200 to 1000 kg/cm<sup>2</sup>.” Applicant has argued that Nakagawa’s “coat reinforcement layer” “consists of a thermoplastics foam form,” which is precluded by the injection conditions in the added limitation.

In the Office action, the Examiner states that “this statement is not supported. A statement or argument by the Applicant’s representative is not factual evidence (MPEP 716.01).”

Applicant again notes that the “200 to 1000 kg/cm<sup>2</sup>” limitation is very specific, and it is clear that Nakagawa does not disclose this limitation. The only way that the claims could be anticipated by Nakagawa would be if this limitation or an equivalent structure were somehow inherent in Nakagawa’s disclosure. However, Applicant notes that the Examiner has not relied on inherency, and has not given any basis in fact and/or technical reasoning for inherency of this limitation, which

U.S. Patent Application Serial No. 09/700,908  
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would be required for an inherency rejection (see MPEP 2112).

Applicant notes that Applicant's previous statement that "a foam resin is precluded by the injection conditions in the present invention" represented Applicant's **technical reasoning** arguments **against** inherency. These arguments were **not** being presented as "factual evidence of nonobviousness" as discussed in MPEP 716.01(d). (Applicant notes that the statements referred to in MPEP 716.01(d) are, for example "statements regarding unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art," etc.). That is, Applicant's statement was not an unsupported statement of an experimental observation, but a scientific reasoning. Applicant therefore submits that Applicant's previous arguments were proper arguments against inherency of the claimed invention in the cited reference, and are entitled to consideration by the Examiner.

Moreover, to supplement Applicant's arguments, Applicant here provides additional evidence in the form of a Declaration under 37 CFR 1.132 by Tsuyoshi Fujiwara, one of the inventors of the present application. In the Declaration, Mr. Fujiwara addresses the results of the injection pressure of the present invention compared to that in Nakagawa JP '688. Mr. Fujiwara concludes that Nakagawa's "coat reinforcement layer" consists of a thermoplastic foam, which is **precluded** by the recited injection pressure of 200 to 1000 kg/cm<sup>2</sup> in claim 25. (Mr. Fujiwara mistakenly refers to claim 27 instead of claim 25, on page 2, 2<sup>nd</sup> line from the bottom, of the declaration). Applicant argues that Nakagawa's product cannot be physically the same as the article of claim 25, which is made with the process limitation of "injection molding at an injection pressure of 200 to 1000 kg/cm<sup>2</sup>."

U.S. Patent Application Serial No. **09/700,908**  
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Reply to OA dated September 14, 2004

In view of the lack of disclosure in Nakagawa of the limitations of claim 25, and Applicant's additional arguments that the limitations of claim 25 cannot have been inherent in Nakagawa, Applicant submits that claims 25, 11, 12 and 16 are not anticipated by Nakagawa.

**Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over Nakagawa in view of Adams et al., and in further view of Akamatsu.** (Office action paragraph no. 7)

The rejection of claim 14 is respectfully traversed, and reconsideration of the rejection is requested.

In traversing the rejection, Applicant notes the above arguments regarding the rejection of base claim 25 over Nakagawa JP '688. Applicant submits that Nakagawa does not disclose or suggest an article meeting the limitations of claim 25, in particular in view of the process limitation of an "injection pressure of 200 to 1000 kg/cm<sup>2</sup>."

Adams and Nakamatsu are cited for the use of acrylonitrile-butadiene-styrene. However, Applicant submits that these references do not disclose or suggest the injection pressure limitation of claim 25.

Applicant therefore asserts that claim 14 is novel and non-obvious over Nakagawa (JP '688), Adams et al. and Akamatsu, taken separately or in combination.

**Claim 15 is rejected under 35 U.S.C. §103(a) as being unpatentable over Nakagawa in view of Stier et al.** (Office action paragraph no. 8)

U.S. Patent Application Serial No. **09/700,908**  
Amendment filed February 11, 2005  
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The rejection of claim 15 is respectfully traversed, and reconsideration of the rejection is requested.

In traversing the rejection of claim 15, Applicant argues as above that the limitations of base claim 25 are not disclosed or suggested by Nakagawa. Stier et al. is cited in particular for the disclosure of slip-resistant surface having finely divided abrasive materials embedded in a film. Applicant asserts that Stier et al. does not disclose or suggest the limitations of claim 25, in particular the injection molding pressure limitation.

Applicant also notes that the Examiner states that “the process limitation of claim 15’ had not been given weight for the reasons provided in paragraph 11 of the Final Rejection mailed March 30, 2004.” Applicant argues, however, that the process limitation of claim 15 does affect the structure of the resulting article, and should be given weight. Applicant submits that the references do not suggest this process limitation and therefore do not suggest the article resulting from this limitation.

Claim 15 is therefore novel and non-obvious over Nakagawa and Stier et al., taken separately or in combination.

**Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over Nakagawa in view of Seymour et al. (Office action paragraph no. 9)**

The rejection of claim 17 is respectfully traversed, and reconsideration of the rejection is requested.

U.S. Patent Application Serial No. **09/700,908**

Amendment filed February 11, 2005

Reply to OA dated September 14, 2004

In traversing the rejection of claim 17, Applicant argues as above that the limitations of base claim 25 are not disclosed or suggested by Nakagawa. Seymour et al. is cited in particular for the recitation of reinforcing ribs. However, Seymour et al. does not suggest the limitations of base claim 25, in particular the injection pressure limitation.

Claim 17 is therefore novel and non-obvious over Nakagawa and Seymour et al.

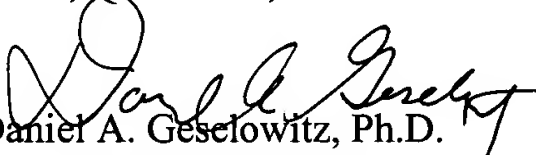
U.S. Patent Application Serial No. **09/700,908**  
Amendment filed February 11, 2005  
Reply to OA dated September 14, 2004

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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PATENT TRADEMARK OFFICE

Attachment: Declaration under 37 CFR 1.132

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